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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,326	02/13/2002	Yasuo Ohtsuka	2002_0194	6036

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,326

Applicant(s)

OHTSUKA ET AL.

Examiner

Brenda L. Coleman

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1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-39 is/are pending in the application.
- 4a) Of the above claim(s) 22-30 and 33-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31, 32 and 37-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/509,494.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/7/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 22-39 are pending in the application.

This action is in response to applicants' amendment dated December 7, 2004. Claims 31 and 32 were amended, claims 19-21 were canceled and claims 37-39 are newly added.

Election/Restrictions

1. Claims 22-30 and 33-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 30, 2004.

Response to Arguments

Applicant's arguments filed December 7, 2004 have been fully considered with the following effect:

2. The applicant's amendments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled paragraph 6) of the last office action, which are hereby **withdrawn**.

In view of the amendment dated December 7, 2004, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 37-39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The definition of R^2 , R^3 , R^4 and R^5 , where R^2 , R^3 , R^4 and R^5 includes the moiety " $-C=N-OR^{16}$ " where R^{16} is a hydrogen atom, C_{1-6} alkyl, phenyl C_{1-4} alkyl, or phenyl as well as a C_{1-6} alkyl which may be substituted by a saturated or unsaturated five- to seven-membered heterocyclic ring is not defined in the specification with respect to the genus of Formula (IIa').

Applicant is required to cancel the new matter in the reply to this Office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 31, 32 and 37-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claim 31 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 , where R^2 , R^3 , R^4 and R^5 includes the moiety " $C=N-OR^{16a}$ ". It is not known what else is bound to the carbon atom which is not valence satisfied.
- b) Claim 32 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 , where R^2 , R^3 , R^4 and R^5 includes the moiety "-

$C=N-OR^{16a}$. It is not known what else is bound to the carbon atom which is not valence satisfied.

c) Claim 37 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 , where R^2 , R^3 , R^4 and R^5 includes the moiety " $C=N-OR^{16}$ ". It is not known what else is bound to the carbon atom which is not valence satisfied.

d) Claim 37 is vague and indefinite in that it is not known what is meant by the moiety $-C=NR^{16}$, where there are two different definition for the variable R^{16} .

e) Claim 38 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 , where R^2 , R^3 , R^4 and R^5 includes the moiety " $C=N-OR^{16}$ ". It is not known what else is bound to the carbon atom which is not valence satisfied.

f) Claim 38 is vague and indefinite in that it is not known what is meant by the moiety $-C=NR^{16}$, where there are two different definition for the variable R^{16} .

g) Claim 39 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 , where R^2 , R^3 , R^4 and R^5 includes the moiety " $C=N-OR^{16}$ ". It is not known what else is bound to the carbon atom which is not valence satisfied.

h) Claim 39 is vague and indefinite in that it is not known what is meant by the moiety $-C=NR^{16}$, where there are two different definition for the variable R^{16} .

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda L. Coleman
Primary Examiner
Art Unit 1624

February 14, 2005